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09/918,419	07/30/2001	Stephen R. Bolt	01-10730-RA3	4570

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Myers & Associates
Intellectual Property Law, P.C.
Building 3, Suite 200
1827 Powers Ferry Road
Atlanta, GA 30339

EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/918,419

Applicant(s)
Bolt

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 21, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1
2 1. Receipt of the amendment filed April 21, 2003 amending claims 1-6 and adding claims
3 7 and 8 is acknowledged. Claims 1-8 are pending in the application and are presented to be
4 examined upon their merits.
5
6

Response to Arguments

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9 2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in
10 view of the new ground(s) of rejection.
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Claim Rejections - 35 USC § 112

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15 3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

16 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
17 the subject matter which the applicant regards as his invention.
18

19 4. Claims 4-6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being
20 indefinite for failing to particularly point out and distinctly claim the subject matter which
21 applicant regards as the invention. It is unclear whether claims 4-6 and 8 are apparatus or
22 method claims. Applicant uses the word "system" in the claims. The use of this word is the

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1 aforementioned claims is ambiguous because its definition can connote an apparatus and/or a
2 method. The distinction of whether or not claims 4-6 and 8 apply towards an apparatus or
3 method is further confused by the fact that the applicant has set forth limitations that have both
4 elements. For examination purposes claims 4-6 and 8 will be considered method claims.

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8 *Claim Rejections - 35 USC § 102*

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10 5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form
11 the basis for the rejections under this section made in this Office action:

12 A person shall be entitled to a patent unless -

13 (e) the invention was described in-

14 (1) an application for patent, published under section 122(b), by another filed in the United States before
15 the invention by the applicant for patent, except that an international application filed under the treaty
16 defined in section 351(a) shall have the effect under this subsection of a national application published
17 under section 122(b) only if the international application designating the United States was published
18 under Article 21(2)(a) of such treaty in the English language; or

19 (2) a patent granted on an application for patent by another filed in the United States before the invention
20 by the applicant for patent, except that a patent shall not be deemed filed in the United States for the
21 purposes of this subsection based on the filing of an international application filed under the treaty defined
22 in section 351(a).

23
24 6. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Shaughnessy
25 (hereinafter "'151", US 6,484,151 B1).

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2 **Re claim 1:**

3 '151 discloses a method for comparing investments selected by a user with *at least one activity*
4 also selected by the user, through a computer accessible for on-line interactive communication
5 with users (see '151, Abstract, col. 1, ll. 35+), comprising the steps of:

6 a. maintaining a list of *activities* with the capability of the user selecting *at least*
7 *one activity* from the list (see '151, abstract, col. 1, ll. 35+; and col. 7, ll. 33+)

8 b. maintaining a database of the investments of the investment funds with
9 information on each investment as to the list of *activities* and *identifying the activities directly*
10 *or indirectly engaged in by each investment* (see '151, col. 8, ll. 35+); and

11 c. providing an interactive on-line access to users to select a *at least one activity*
12 and screen selected investments funds in respect to *any activity* selected (see '151, col. 8, ll.
13 35+).

14
15 **Re claim 2:**

16 '151 discloses providing users with the capability of selecting *at least one activity* and
17 providing search engine capability to design a search of funds to fit the user's selected *activity*
18 (see '151, figs. 2d,e, 3a, col. 8, ll. 35+).

19

20

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1 **Re claim 3:**

2 '151 discloses a computer readable substrate having a computer program save thereon, the
3 computer program comprising steps of:

4 a. providing a user with on-line access to a list of *activities* homepage and a list of
5 funds homepage (see col. 6, ll. 6+; and col. 8, ll. 1-67);

6 b. providing the user with the capability of selecting at least one activity from the
7 list of activities (see col. 8, ll. 1-67); and

8 c. providing the user with the capability of selecting of fund and screening that
9 fund or activity selected by the user (see col. 8, ll. 1-67).

10
11 **Re claim 4:**

12 '151 discloses supplying of information concerning whether any investment of a selected
13 investment fund is directly or indirectly involved in any activity related to an activity selected
14 by the user from a list of activities:

15 a. a first memory area for storing a list of activities (see col. 17, ll. 58 to col. 18,
16 ll. 47); and

17 b. a second memory area for storing information on the list of activities engaged in
18 directly of indirectly, by an investment fund in a list of investment funds (see col. 8, ll. 1-67;
19 and col. 17, ll. 58 to col. 18, ll. 47).

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2 **Re claim 5:**

3 '151 discloses

4 a. providing a user with on-line access to the list of activities homepage and to the
5 list of activities homepage and to the list of investment funds homepage, the list of activities
6 homepage linking to the first memory area, the list of investment funds homepage linking to
7 the second memory area (see col. 8, ll. 1-67; and col. 12, ll. 3+);

8 b. providing on-line capabilities of viewing each of the homepages and selecting
9 and activity and investment fund (see col. 8, ll. 1-67; and col. 12, ll. 3+); and

10 c. providing on-line capability of screening each investment fund selected in
11 relation to the activity selected and providing the user with the capability of viewing the results
12 (see col. 8, ll. 1-67; and col. 12, ll. 3+).

13
14 **Re claim 6:**

15 '151 providing the user with search engine capability to design a search of investment funds
16 that meet user's criteria of activities (see PMP, col. 6, ll. 6+)

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1 **Re claim 7:**

2 '151 the database of investments of investment funds also identifies the extent of an
3 investment's involvement in each activity on the list of activities for such investment (see col.
4 8, ll. 1-67).

5
6 **Re claim 8:**

7 '151 discloses that the second memory area also stores information on the extent of the
8 investment fund's activity in each activity stored in the second memory area (see col. 8, ll. 1-
9 67).

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13 ***Conclusion***

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15 7. Applicant's amendment necessitated the new ground(s) of rejection presented in
16 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
17 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18 A shortened statutory period for reply to this final action is set to expire THREE
19 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
20 MONTHS of the mailing date of this final action and the advisory action is not mailed until after
21 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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1 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR
2 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,
3 will the statutory period for reply expire later than SIX MONTHS from the date of this final
4 action.

5
6 8. Any inquiry concerning this communication or earlier communications from the examiner
7 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The
8 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
9 Any inquiry of a general nature relating to the status of this application or its proceedings should
10 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
11 **Vincent Millin** whose telephone number is (703) 308-1065.

12
13 9. Response to this action should be mailed to:

14
15 Commissioner of Patents and Trademarks

16 Washington, D.C. 20231

17 for formal communications intended for entry, or (703) 305-0040, for informal or draft
18 communications, please label "Proposed" or "Draft".

19 Communications via Internet e-mail regarding this application, other than those under 35
20 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
21 addressed to *[daniel.felten@uspto.gov]*.

22
23 All Internet e-mail communications will be made of record in the application file. PTO
24 employees do not engage in Internet communications where there exists a possibility that
25 sensitive information could be identified or exchanged unless the record includes a properly

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1 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
2 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
3 Trademark on February 25, 1997 at 1 195 OG 89.

4
5 
6
7 DSF

8 July 17, 2003


HANI M. KAZIMI
PRIMARY EXAMINER